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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,391	12/30/1999	CARLOS A. SILVA JR.	06975/048001	6275

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EXAMINER

BAUGH, APRIL L

ART UNIT PAPER NUMBER

2141

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

19

Office Action Summary	Application No. 09/475,391	Applicant(s) SILVA ET AL.	
	Examiner April L Baugh	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 36-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 26, 2003 has been entered.

Response to Amendment

Applicant has canceled claims 1-35 and added new claims 36-55, therefore claims 36-55 are now pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 36-43 and 47-52 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,081,830 to Schindler in view of Porter and further in view of Applicant Admitted Prior Art (AAPA).

Regarding claim 36, Schindler teaches a method of providing a buddy list to a network user, the method comprising: determining television programming selected for viewing by a network user at a networked device (column 2, lines 6-16); selecting a chat room based upon the determined television programming (column 3, lines 54-56).

Schindler does not teach selecting a buddy list based on television programming. Porter teaches selecting an initial buddy list from among two or more pre-defined buddy lists based upon the determined television programming (column 1, lines 26-27 and column 10, lines 25-28). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler by selecting a buddy list based on television programming because just as a user may choose to chat in a particular chat room where those present are discussing a particular program, the user may also want to instant message a user from a pre-defined buddy list of users who care to discuss that particular program as well.

Schindler in view of Porter does not teach of a pre-defined buddy list of network users, wherein the list displayed on an IM user interface comprises online presence information for the members of the list. AAPA teaches each buddy list comprising one or more members defined by the network user, the members comprising one or more other network users; and displaying the selected buddy list to the network user on an instant messaging user interface, wherein the displayed buddy list comprises online presence information for the members of the buddy list (pg. 3, lines 12-18). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by having a pre-defined buddy list of network users, wherein the list displayed on

an IM user interface comprises online presence information for the members of the list because the user knows which network user care to discuss particular programs so the list must be pre-defined and displaying the list on the IM UI allows the user to instant message those that are currently online for immediate discussion of the program.

Regarding claim 47, Schindler teaches a computer program disposed on a computer readable medium for providing a buddy list to a network user, the computer program including instructions for causing a processor to: determine television programming selected for viewing by a network user at a networked device (column 2, lines 6-16); select a chat room based upon the determined television programming (column 3, lines 54-56).

Schindler does not teach selecting a buddy list based on television programming. Porter teaches select an initial buddy list from among two or more pre-defined buddy lists based upon the determined television programming (column 1, lines 26-27 and column 10, lines 25-28). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler by selecting a buddy list based on television programming because just as a user may choose to chat in a particular chat room where those present are discussing a particular program, the user may also want to instant message a user from a pre-defined buddy list of users who care to discuss that particular program as well.

Schindler in view of Porter does not teach of a pre-defined buddy list of network users, wherein the list displayed on an IM user interface comprises online presence information for the members of the list. AAPA teaches each buddy list comprising one or more members defined by the network user, the members comprising one or more other network users; and displaying the

selected buddy list to the network user on an instant messaging user interface, wherein the displayed buddy list comprises online presence information for the members of the buddy list (pg. 3, lines 12-18). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by having a pre-defined buddy list of network users, wherein the list displayed on an IM user interface comprises online presence information for the members of the list because the user knows which network user care to discuss particular programs so the list must be pre-defined and displaying the list on the IM UI allows the user to instant message those that are currently online for immediate discussion of the program.

Referring to claims 43 and 52, Schindler teaches the method of claim 36 and 47 further comprising receiving information indicating a change in the television programming viewed by the network user (column 4, lines 59-65); selecting a different chat room based upon the changed television programming (column 2, lines 6-16).

Schindler does not teach selecting a different buddy list from among two or more pre-defined buddy lists based upon the changed television programming. Porter teaches selecting a different buddy list from among two or more pre-defined buddy lists based upon the changed television programming (column 1, lines 26-27 and column 10, lines 25-28). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler by selecting a different buddy list from among two or more pre-defined buddy lists based upon the changed television programming because just as a user may choose to chat in a particular chat room where those present are discussing a particular program, the user may also want to instant message a user from a pre-

defined buddy list of users who care to discuss that particular program as well. Therefore if there is a change in television programming then the buddy list of users who choose to discuss the new programming will change as well.

Schindler in view of Porter does not teach displaying the different buddy list to the network user on an instant messaging user interface. AAPA teaches displaying the different buddy list to the network user on an instant messaging user interface (pg. 3, lines 12-18). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by displaying the different buddy list to the network user on an instant messaging user interface because displaying the new list on the IM UI allows the user to instant message those that are currently online for immediate discussion of the new program the user has switched to.

Regarding claims 37 and 48, Schindler teaches the method of claim 36 and 47 wherein determining television programming comprises determining a television network (column 3, lines 46-56).

Referring to claims 38 and 49, Schindler teaches the method of claim 36 and 47 wherein determining television programming comprises determining a television show (column 4, lines 12-16).

Regarding claims 39 and 50, Schindler teaches the method of claim 36 and 47 wherein determining television programming comprises determining a characteristic of a television show (column 1, lines 25-26).

Referring to claims 40 and 51, Schindler teaches the method of claim 39 and 50 wherein determining a characteristic comprises determining a type of the television show (column 1, lines 25-26).

Regarding claim 41, Schindler teaches the method of claim 40 wherein the type comprises sports (column 1, lines 23-29).

Referring to claim 42, Schindler teaches the method of claim 41 wherein determining television programming comprises determining a sports team (column 1, lines 23-29).

4. Claims 44-46 and 53-55 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,081,830 to Schindler in view of Porter and further in view of Applicant Admitted Prior Art (AAPA) as applied to claims 36-43 and 47-52 above, and further in view of DeSimone et al.

Regarding claims 44 and 53, Schindler in view of Porter and further in view of AAPA teaches multiple buddy lists (column 2, lines 6-16 of Schindler and column 1, lines 26-27 and column 10, lines 25-28 of Porter).

Schindler in view of Porter and further in view of AAPA does not teach different buddy list. DeSimone et al. teaches the method of claim 43 and 52 wherein the different buddy list differs from the initial buddy list (column 2, lines 4-6 and 12-14 and column 14, lines 63-65). Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter and further in view of AAPA by having different buddy list because each buddy list will contain users that are interested in discussing different programs

Art Unit: 2141

therefore as the user changes programs they will have a list of user willing to discuss that new program.

Regarding claims 45 and 54, Schindler in view of Porter and further in view of AAPA teaches multiple buddy lists (column 2, lines 6-16 of Schindler and column 1, lines 26-27 and column 10, lines 25-28 of Porter).

Schindler in view of Porter and further in view of AAPA does not teach wherein at least one member of the different buddy list differs from the members of the initial buddy list. DeSimone et al. teaches the method of claim 43 and 52 wherein at least one member of the different buddy list differs from the members of the initial buddy list (column 2, lines 4-6 and 12-14 and column 14, lines 63-65). Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter and further in view of AAPA by wherein at least one member of the different buddy list differs from the members of the initial buddy list because each buddy list will contain users that are interested in discussing different programs therefore as the user changes programs they will have a list of user willing to discuss that new program.

Regarding claims 46 and 55, Schindler in view of Porter and further in view of AAPA teaches multiple buddy lists (column 2, lines 6-16 of Schindler and column 1, lines 26-27 and column 10, lines 25-28 of Porter).

Schindler in view of Porter and further in view of AAPA does not teach wherein the members of the different buddy list differ from the members of the initial buddy list. DeSimone et al. teaches the method of claim 43 and 52 wherein the members of the different buddy list

differ from the members of the initial buddy list (column 2, lines 4-6 and 12-14 and column 14, lines 63-65). Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter and further in view of AAPA by wherein the members of the different buddy list differ from the members of the initial buddy list because each buddy list will contain users that are interested in discussing different programs therefore as the user changes programs they will have a list of user willing to discuss that new program.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April L Baugh whose telephone number is 703-305-5317. The examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal D Dharia can be reached on 703-305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

ALB


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER